

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/541,090 Confirmation No.:
Applicant(s): Temple, Kit
Filed: 12/18/2003
Art Unit:
Examiner:
Title: Distributing Content Data
Attorney Docket No.: 856.0007.U1(US)
Customer No.: 29,683

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Renewed Petition Under 37 CFR §1.47(b)

Sir:

Applicant's attorney requests reconsideration of the petition under 37 CFR §1.47(b) in the above-identified patent application.

Enclosed is the following additional items to support this petition:

- Statement by person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 C.F.R. 1.47(b) applicant.
- Copy of Invention Report signed by the non-signing inventor.

The Decision On Petition Under 37 C.F.R. 1.47(b) mailed 17 April 2007 stated that the following two items were not satisfied:

- Item (2) - factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; and
- Item (5) - proof that the 37 C.F.R. 1.47(b) applicant has sufficient proprietary interest in the application.

In regard to item (2), it should be noted that merely because someone other than James Seymour signed the letters to the non-signing inventor for James Seymour, does not mean that James Seymour did not have first hand knowledge of the letters in the first place. **The USPTO was wrong** to disregard Mr. James Seymour's declaration (signed under 18 U.S.C. 1001) stating that he had first hand knowledge that the inventor refuses to execute the application or cannot be reached after diligent effort. However, to accelerate prosecution of this application, attached is an additional Statement of Facts signed by Angela Brain who signed the letters of August 15, 2005 and September 28, 2005 for James Seymour.

In regard to Item (5), the USPTO has stated that in order to satisfy 37 C.F.R. 1.47(b) a signed declaration in accordance with 18 U.S.C. 1001 is insufficient proof of a proprietary interest unless the declaration also identifies facts upon which the first hand knowledge is based; that a mere declaration that such first hand knowledge exists is insufficient. **Again, the USPTO was wrong** to disregard Mr. James Seymour's declaration signed under 18 U.S.C. 1001 stating that he had first hand knowledge that applicant has

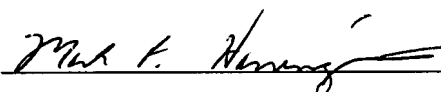
sufficient proprietary interest in the application. The prior statement of Facts signed by Mr. Seymour clearly states:

"I declare that the invention described and claimed in U.S. patent application No. 10/541,090 was made by Kit Temple while employed by Nokia (UK) Ltd."

The arbitrary and capricious decision by the USPTO to ignore this declaration (signed under 18 U.S.C. 1001) appears to be clearly in error. However, to accelerate prosecution of this application, attached is a copy of an Invention Report signed by the non-signing inventor (Kit Temple) while he was employed by the applicant, and identifying the non-signing inventor by his employee number in the company. Please note that on page 1 of the Invention Report it is clearly indicated that the company may be entitled to rights to the invention.

In view of the above, the USPTO is requested to reconsider the petition filed under 37 C.F.R. 1.47(a).

Respectfully submitted,


Mark F. Harrington (Reg. No. 31,686)

6/7/07
Date

Customer No.: 29683
Harrington & Smith, PC
4 Research Drive
Shelton, CT 06484-6212
203-925-9400

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

6/7/2007
Date

Elaine F. Main
Name of Person Making Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Customer No.: 29,683

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Statement of Facts to Support
Petition Under 37 CFR §1.47(a)

Sir:

The undersigned hereby declares:

I, Angela Brain, am a legal assistant in the patent department for Nokia Corporation.

Attached as Exhibit A is a copy of a letter I signed and mailed to Kit Temple on August 15, 2005 for James Seymour.

Attached as Exhibit B is a copy of a letter I signed and mailed to Kit Temple on September 28, 2005 for James Seymour.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 25 May 07

By: A. Brain

Name: Angela Brain

Exhibit A

Mr Kit Temple
Iris House,
Pyrford Road,
Woking,
Surrey
GU22 8UQ

15 August 2005

Dear Kit

New US Patent Application
"Distributing Content Data"
Inventor : Kit Temple

Our ref: NC 33804 US (PAT 02014*US)

In connection with our proposed US patent application, would you please sign and date the enclosed Declaration and Assignment documents at the two places indicated, using the same date on both documents.

A copy of the patent specification is attached to the Declaration. Please read the documents, including the specification, carefully before signing.

I would be ready to authorise payment of a reasonable, modest consultancy fee for dealing with this matter, if you complete and return the attached standard form of invoice. In the circumstances I feel that this consultancy fee would not exceed £100.

Do not hesitate to call me if there is anything you would like to discuss.

Please return the signed papers to me as soon as possible. A stamped addressed envelope is enclosed for your convenience.

Yours sincerely

J.P. A. Brain
James Seymour

JS/ab/0031

Enes: Declaration and Assignment documents
Patent specification (attached to Declaration)
Additional copy of patent specification for your retention

Exhibit B

NOKIA

Mr Kit Temple
Iris House,
Pyrford Road,
Woking,
Surrey
GU22 8UQ

28 September 2005

Dear Kit

New US Patent Application
"Distributing Content Data"
Inventor : Kit Temple

Our ref: NC 33804 US (PAT 02014*US)

We wrote to you previously on the 15 August 2005. However we have not received a reply so I am writing to you again in connection with our proposed US patent application. Would you please sign and date the enclosed Declaration and Assignment documents at the two places indicated, using the same date on both documents.

A copy of the patent specification is attached to the Declaration. Please read the documents, including the specification, carefully before signing.

I would be ready to authorise payment of a reasonable, modest consultancy fee for dealing with this matter, if you complete and return the attached standard form of invoice. In the circumstances I feel that this consultancy fee would not exceed £100.

Do not hesitate to call me if there is anything you would like to discuss.

Please return the signed papers to me as soon as possible. A stamped addressed envelope is enclosed for your convenience.

Yours sincerely

James Seymour

James Seymour

Encls: Declaration and Assignment documents

Patent specification (attached to Declaration)

JS/ab/0033

NOKIA IPR DEPARTMENT
Nokia House
Summit Avenue
Farnborough
Hampshire
GU14 0NG
UK

Additional copy of patent specification for your retention

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Registered Office:
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NOKIA☐ COMP RECORD
☐ FILE RECORD
☐ DIARY
CONFIDENTIALDocument date: 17.7.2002

Invention report

NC 33804

1/2

INVENTION REPORT

Title of invention: Java Cards		17 JUL 2002	INVENTION REPORT RECEIVED	
		<input type="checkbox"/> RENEWAL RECORD <input type="checkbox"/> CITATIONS	Code: 33804	Patent Committee
THE DESCRIPTION OF THE INVENTION MUST BE ATTACHED		<input type="checkbox"/> INV AWARD	Place:	Date:
		<input type="checkbox"/> LETTER: CC	Signature:	
Inventor's name, employee number, title and nationality: *) Kit Temple Employee No. 10161173 Title. Mr Nationality. Dual English/French		Home Address: *) 19 Abbey Court Heathcote Road Camberley GU15 2HR		Business Unit and cost centre: Business Insights 3144025
Line Manager(s): Gary Kite				
Project : *)		Project Manager:		
Office address: *) Nokia, Ashwood House, Pembroke Broadway, Camberley, Surrey. GU15 3XD				
Phone: *) +44 1252 865322 / +44 7979 537068		Fax: *) 01252 865089		
The invention becomes public on: Unknown				
<i>I am/ We are the sole/ and original inventor(s) of this invention.</i>				
<i>The company may, by virtue of applicable legislation, be entitled to full or partial rights to the invention.</i>				
<i>I/ We acknowledge my/ our obligation to sign as inventor(s) all documents that may be required for protecting the invention in different countries.</i>				
Applicable to inventions made by inventors employed in FI, DK, DE and SE only.				
<i>Unless the inventor requests the Invention Report to be responded to within four (4) months from the date this Invention Report is received or such other period as the mandatory provisions of the applicable local law may otherwise require, the inventor consents to the right of the employer to use a reasonable period of time for the evaluation of the invention. A reasonable period of time may exceed four (4) months.</i>				
<input type="checkbox"/> I/ We request that the Invention Report be responded to within four (4) months.				
Date: 15/7/02				
Signature(s) of Inventor(s): 				

*) See the instructions

I have read and understood the invention described in this Invention Report

Date: 15/7/02

Signature of Manager



DESCRIPTION OF THE INVENTION

Please, describe your invention in the following order. You can enclose the drawings on a separate document.

1. Field and background of the invention

Original idea, no background

2. A summary of the invention

Packs of randomised cards are sold. The cards are around the size of a playing card, with a large image at the top and an associated card game that can be played with the cards. On each card is a rectangle with a unique code, covered by silver foil. The foil can be scratched off and sent via a mobile phone to a Nokia server that will send back the content the code relates to.

Content will be predominantly Java games and new game levels. However, ringtones, wallpaper and screensavers may also be included. In other Java Card releases, alternative content such as video and audio clips, Java utilities and MMS images may be used.

3. Describe the problem which the invention overcomes

Overcomes user resistance to virtual purchase, overcomes the problem of inability to sell Java games in a retail environment

4. How was the problem solved earlier?

No prior solutions – all Java game purchases have been presented as straight virtual purchases

5. How does the invention improve earlier solutions? Advantages and disadvantages of the invention?

Advantages: Ability to purchase in a retail environment. Creates a physical collectable for a virtual purchase. Social advantages for collectors through interaction in swapping the cards. Game within a game (Java Cards are also a simple card game), and the simple collectability of cards allows non-Java phone owners to enjoy the purchase of Java Cards.

Disadvantages: To avoid problems with copyright, user can only download the game using the Java Card code one time

6. Brief description of the drawings (Please enclose drawings and figures of the invention on a separate document)**7. A more detailed description of the invention (if known at the moment)**

Note: Taken from draft service brief – not necessarily the finalised idea

I have read and understood the invention described in this Invention Report

Date: 15/7/02
Signature of Manager



Theme ringtones – rare
Theme screensaver – ultra-rare

Initial theme could be Star Wars. Other themes could be based around the latest crazes – often fuelled by cinema film releases such as Spiderman

Future Java Card launches could focus on other non-games focused markets.

For example:

MP3 clips, ringtones, wallpaper and screensavers based on Pop group boy bands aimed at teenage girls.

Games, calendars, match planners, wallpapers, MMS images, ringtones and screensavers based on World Cup soccer stars aimed at boys

8. Explain, how the invention is/can be implemented. Which would be the best mode of implementation?

In order that the user can quickly and simply obtain the Java game after scratching off the foil and revealing the code, two methods can be employed:

- A java utility (pre-installed or downloaded) can reside on the phone. The user activates the java utility, types the code into a box and selects Send. The java utility sends the code to the Nokia server, which checks what game (or ringtone, music clip etc.) the code relates to and validates that the code has not already been used, and then sends the appropriate content back to the phone

The user sends the code via SMS to a simple number – similar to the Club Nokia method of purchasing a ringtone where the user sends a command like GET TEENAGED to the number 84000 in order to get the ringtone Teenage Dirtbag. This feature is not feasible on current Nokia Java handsets such as the 7650, but is possible on future handsets

9. Explain how we can recognise if a competitor is using the same product/feature?

If a competitor were making the same product, they would appear for sale in retail shops around the world

**10. Is it planned to use the invention in a Nokia product? If so, when and in which product?
Is the invention standard related?**

Invention is for use with Java enabled mobile handsets.

11. Abbreviations

12. Any further comments

I have read and understood the invention described in this Invention Report

Date: 15/7/02
Signature of Manager



1. Service Description

This concept is a way to distribute Java games (and many other forms of content) to a predominantly young audience through physical collectable "Java Cards"

Java Cards will look similar to Pokemon cards, around the size of a normal playing card, with a colour image and a small silver foil covered rectangle that can be scratched off to reveal a code that allows the user to download the content (eg. a Java game) from Nokia. The cards are distributed in sealed packs of 5-8 cards per pack, and sold in retail stores

1.1 Collectability driving uptake

The card packs are randomised, so children will instantly start swapping the cards at school. Valid game cards can be instantly recognised by the fact the code box is still covered by silver foil. Because these cards will become a collectable and will impact on social status, children without Java phones will collect them, just as Pokemon cards were predominantly collected by children who did not know how to play the card game

Since the majority of collectors will not have a Java-enabled phone, the most desired item for their Birthday/Xmas will immediately become a Java game phone

To further fuel collectability, ultra-rare game cards will exist which will make those finding such a card the center of attention of others who want to try the game

1.2 Game within a game

Desirability will be further increased by making the cards into a Top Trumps type card game (a simple game where the winning player names a chosen factor from the list, and the highest score take both cards – player with all the cards wins). The cards could be given ratings such as Fun Factor, Coolness, Brain Strain etc.

This will increase the desire to purchase the cards, and increase the need to purchase many cards (to be able to build a deck with very strong cards to increase chances of winning the games that are played)

1.3 Strong topical brands will fuel the craze

It is important that strong partner brands are used in creating themed card packs. Such as having Star Wars themed Java Card decks, rather than less exciting themes such as Puzzle games theme

1.4 Contents Java Card packs

For the initial launch, card packs would contain:

Java games – common

Extra levels for Java games – common

Theme wallpaper – rare

I have read and understood the invention described in this Invention Report

Date: 15/7/02
Signature of Manager

